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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,216	07/20/2000	PETER FICKEISEN	193413USOPCT	2523
22850	7590	09/14/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			SHOSHO, CALLIE E	
			ART UNIT	PAPER NUMBER
			1714	
DATE MAILED: 09/14/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/582,216		FICKEISEN ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Callie E. Shosho		1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-14, 16-26, 28, 31, 32, 36-52 and 54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31, 32, 36-52 and 54 is/are allowed.
- 6) ☒ Claim(s) 9 and 22 is/are rejected.
- 7) ☒ Claim(s) 10-14, 16-21, 23-26 and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. All outstanding objections and rejections except for those described below are overcome by applicants' amendment filed 6/30/05.

#### **Double Patenting**

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 9 and 22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 7 of U.S. Patent No. 6,409,860 (U.S.

Fickeisen et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the explanation given in paragraph 3 of the office action mailed 4/25/05.

4. Claims 9 and 22 directed to an invention not patentably distinct from claims 1 and 7 of commonly assigned Fickeisen et al. Specifically, although the conflicting claims are not identical, they are not patentably distinct for the reasons set forth in paragraph 3 above.

5. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned U.S. 6,409,860), discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

**Response to Arguments**

6. Applicants argue that the double patenting rejection of record is overcome in light of the comparative data set forth in the present specification that establishes the significant improvement in wet bonding capacity that is achieved by the present invention.

While the examiner agrees that a double patenting rejection can be rebutted using comparative data to establish unexpected or surprising results, in the present application, the data is not persuasive and does not overcome the double patenting rejection of record given that the data is not commensurate in scope with the scope of the present claims.

Specifically, the data set forth in the present specification, namely, Tables 1-3, compares composition within the scope of the present claims, i.e. comprising polymer with gel content and number average molecular weight (Mn) as presently claimed, with composition outside the scope of the present claims, i.e. comprising polymer with gel content and Mn outside the scope of the present claims, but within the scope of Fickeisen et al. It is shown that the composition of the present invention is superior in terms of wet bonding capacity.

However, it is the examiner's position that the data is not commensurate in scope with the scope of the present claims for the following reasons. Firstly, as set forth in Table 2, the coating utilized in all the examples contains 45.8% filler which is outside the scope of the present claims which all require 50-80% filler. Further, Table 2 discloses the use of filler known under the tradename Ulmer Weiss XM, however, there is no disclosure of what type of filler this is, i.e. chalk, quart flour, etc., or what the average particle diameter of the filler is. Thus, it is not clear if the filler of the examples falls within the scope of the present claims. Clarification is requested.

Further, Tables 1 and 2 disclose that the composition comprises Acronal. However, there appears to be no disclosure in the present specification regarding Acronal 378 or Acronal DS and thus, it is not clear if these tradenames represent polymer that comprises 60-100% by wt. of a C<sub>1</sub>-C<sub>20</sub> alkyl (meth)acrylate or mixture of at least two C<sub>1</sub>-C<sub>20</sub> alkyl (meth)acrylates as required in all the present claims. Clarification is requested. Additionally, it is noted that Table 1 refers to Acronal 378 while Table 2 refers to Acronal DS 378. It is not clear what, if any, difference there is between Acronal 378 and Acronal DS 378. Clarification is requested.

Also, based on the data on Table 2 which discloses the type and amount of each ingredient present in the composition, the only proper side-by-side comparison that can be made is between examples 3 and 4 which each disclose composition comprising identical types and amount of ingredients with the exception of the gel content and Mn of the polymer. Thus, the data is also not commensurate in scope with the scope of the present claims given that there is only data at one gel content and one number average molecular weight and there is no data at the upper or lower ends of either the gel content range or Mn range.

In light of the above, it is the examiner's position that the comparative data is not successful in overcoming the double patenting rejection of record.

**Allowable Subject Matter**

7. Claims 10-14, 16-21, 23-26, and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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8. Claims 31-32, 36-52, and 54 are allowable over the “closest” prior art Fickeisen et al. (U.S. 6,409,860) for the following reason.

As set forth in amended 35 USC 103(c), subject matter which qualifies as prior art under one or more subsections (e), (f), and (g) of section 102 cannot be applied against the claimed invention if the prior art and the claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” This rule change to 103(c) applies to any patent application filed on or after November 29, 1999. See Official Gazette, April 11, 2000. As noted in the Official Gazette, the “mere filing of a continuation application on or after November 29, 1999 will serve to exclude commonly owned 102(e) prior art that was applied, or could have been applied, in a rejection under 103 in the parent application.”

Given that the filing date of the present application is subsequent to November 29, 1999, that Fickeisen et al. qualifies as prior art under 102(e), and that applicants have established that the present application and Fickeisen et al. were, at the time the present invention was made, commonly owned, Fickeisen et al. is disqualified as prior art against the present claims.

### **Conclusion**

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

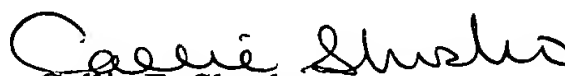
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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Callie E. Shosho  
Primary Examiner  
Art Unit 1714